



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,534	06/04/2001	Lainye Reich	10010987-1	3560

7590 11/16/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
----------	--------------

2135

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/873,534		REICH ET AL.	
	Examiner		Art Unit	
	Tom Gyorfi		2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/20/01</u> . | 6) <input type="checkbox"/> Other: ____. |

1. Claims 1-36 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 7, 8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent 6,192,407).

Regarding claim 7, the invention disclosed by Smith creates [returns] a temporary document address assigned to a document (column 15, lines 8-11 and 32-34), receiving the temporary document address from the remote server by communicating it to a recipient's PC [Internet appliance] by email (column 15, lines 37-40), and having the recipient's PC retrieve the document by issuing a request to the remote server to retrieve a document, using the temporary document address and the Web (column 15, lines 8-11 and also lines 40-41).

Regarding claim 8, the documents can be protected by a password, which is construed to be a form of authentication information (column 15, lines 46-48).

Regarding claim 10, note that the PURL used in the invention is a uniform resource locator address (column 15, lines 8-11).

Art Unit: 2135

4. Claims 11-13, 16-18, 20-23, and 26-36 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smith.

Regarding claims 11, 17, 22, 27, 29, and 33, the system disclosed by Smith contains the features of dynamically assigning a single-use document address to the retrieved document (column 15, lines 32-34), sending the single-use document address to the requesting device (column 15, lines 38-41), downloading/retrieving the document from the server [storage location] according to the single-use document address (column 15, lines 40-41).

Examiner contends that the following aspects of the invention disclosed by Smith are inherently true:

- a. It is inherent to using the Web, and of the HTTP protocol in particular, that by entering a [P]URL into a web browser - either by clicking a hyperlink or by manually typing it in - said web browser necessarily generates a request to the web server for the document identified by the [P]URL.
- b. Pursuant to claims 29 and 33, it is inherent to files and documents stored on a computer that a user would have the ability to manipulate it; such manipulations could include displaying it on a screen, printing the document, editing the content, renaming it, moving it to another directory on a hard drive or to an external storage device, deleting it, etc.
- c. It is inherent to the PURLs as defined by Smith that they are intended for a single use, and consequently would be deleted at some point in time after the document has been downloaded. This assertion is based on their temporary

nature (column 15, lines 8-11) and that each PURL is intended for one specific user; when a document is sent to multiple users, multiple distinct PURLs are generated, one for each intended recipient (column 15, lines 34-38). If Applicant wishes to contest this assertion, a 103(a) rejection will then be raised on the grounds that stipulating that a PURL be a single-use link that is invalidated after a successful download would have been an obvious feature for one of ordinary skill in the art at the time the invention were made to include. Given that the documents are only temporarily stored on the server (column 15, line 32), continuing to promulgate the PURL after the document it references has been removed from the server would serve no purpose except to potentially incur useless web traffic by someone trying to follow a dead link. In addition, leaving a PURL active after a download could potentially be a security risk; a webcrawler might stumble upon a PURL pertaining to a document the sender wished to remain confidential and publicly post the location of said document against the sender's wishes. Invalidating [deleting] the PURL immediately after a successful download would help prevent these situations from occurring

Regarding claims 12 and 20, again note that the PURL is communicated to the recipient via email (column 15, lines 38-40).

Regarding claims 13, 18, and 23, the documents can be protected by a password, which is construed to be a form of authentication information (column 15, lines 46-48).

Regarding claims 16, 21, and 26, note that the PURL used in the invention is a uniform resource locator address (column 15, lines 8-11).

Regarding claim 28, note that the document can be encrypted according to encryption information (column 13, lines 26-30) and decrypted (column 16, lines 10-20).

Regarding claims 30 and 34, note that the recipient can decrypt an encrypted document with the key provided in the single-use address (column 16, lines 10-20).

Regarding claims 31 and 35, note that the recipient of the document can be a printer (elements 176 and 178 of Figure 14).

Regarding claims 32 and 36, observe that the receiving PC appears to possess a monitor for displaying data (element 320 of Figure 20). If Applicant wishes to contend that it is not inherently true that a PC must have a monitor attached, then a 103(a) rejection will be raised on the grounds that it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach a monitor to the PC found in the system disclosed by Smith. Without a monitor, the average user would be hard pressed to see the software and data files that are contained on one's computer.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent 6,192,407).

Regarding claim 1, Smith teaches a system for document retrieval that features the ability to dynamically assign a single-use document address to the requested document, receiving an access request for the Internet appliance, and sending the document to the Internet appliance (column 15, lines 32-42). Note that a PC as illustrated by element 320 of Figure 20 is an Internet appliance under the broadest definition of the term. In addition, while it is not explicitly stated that the dynamically generated URL is deleted after delivery of the document, Smith teaches that the URL is temporary (column 15, lines 8-11). It is therefore Examiner's contention that the single-use document address is deleted at a point in time after the requested document has been sent to the Internet appliance; but even if this were not the case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do so. Note that the document is only temporarily stored on the server (column 15, line 32) so continuing to promulgate the dynamically generated URL after the document it references is removed from the server would serve no purpose except to potentially incur useless web traffic. Deleting the URL would prevent this situation from occurring. Smith also appears to be silent regarding a request for the document address; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by Smith such that the URL sent by email to the recipient (column 15, lines 38-41) instead contains a PURL that, when followed, generates a request for a PURL to the desired document. It is well known by those in

Art Unit: 2135

the art that email can be retained for extended periods of time; so by adding a layer of indirection to the process, a server administrator can ensure that PURLs to documents stored on the server are not retained in any user's mailbox but are truly deleted.

Regarding claim 2, again note that the documents served by Smith's invention can be password protected (column 15, lines 46-48).

Regarding claim 4, observe that the server in Smith's invention sends an email containing the single-use URL (column 15, lines 38-41).

Regarding claim 5, it is readily apparent that the server in Smith's invention is an Internet web server computer, evidenced by its innate support of HTTP (column 5, lines 32-38) and the fact that the recipient uses the Web to access documents from it (column 15, lines 40-41)

Regarding claim 6, note that the PURL used in the invention is a uniform resource locator address (column 15, lines 8-11).

7. Claims 3, 9, 14-15, 19, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claims 1, 7, 11, 17, and 22 above, and further in view of Schneier ("Applied Cryptography", 2nd edition).

Regarding claims 3, 9, 14, 19, and 24, it should be noted that while the files stored on the server can be encrypted, and that decryption can be performed using a key included in the PURL (column 16, lines 10-20), Smith is unclear as to what type of encryption algorithm is employed in this feature. The only reference in Smith's disclosure refers to offering the sender a choice between "Public Encryption" and

Art Unit: 2135

"Private Encryption", with no further clarification (Smith, column 13, lines 26-30). As found in the Schneier reference, these terms would appear to be synonymous with each other, referring to an asymmetric encryption algorithm where separate keys are used for encryption and decryption (Schneier, page 31, "2.5 Communications Using Public-Key Cryptography"). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to offer at least one symmetric encryption algorithm – one that uses the same key for both encryption and decryption (Schneier, page 28, "2.2 - Communications Using Symmetric Cryptography") as a valid choice for encrypting files on the server disclosed by Smith. As Schneier teaches, symmetric algorithms are typically better at encrypting data than public-key asymmetric algorithms, particularly as they are more efficient (Schneier, page 216, "10.2 Public-Key Cryptography vs. Symmetric Cryptography"). Consequently, in the embodiment of the invention by Smith as modified by Schneier, the decryption key communicated to the receiver would by definition also be the encryption key for encrypting the requested document, and that the document would necessarily be encrypted according to this key.

Further regarding claims 9 and 19, in the embodiment of the invention disclosed by Smith as modified by Schneier, when the user follows the link provided by the PURL (Smith, column 16, lines 10-20), the address containing the encryption key used for encrypting the requested document (element 334 of Figure 20) will be communicated back to the server as part of the HTTP request intrinsic to accessing documents via the Web (Smith, column 15, lines 40-41).

Regarding claims 15 and 25, Smith clearly teaches that a decryption key is communicated back to the recipient, and that the document is decrypted using the decryption key (column 16, lines 10-20 and element 334 of Figure 20).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Andrews, Whit. "iSend Lets Users Track File Deliveries". Published August 25, 1998. <http://www.internetnews.com/bus-news/article.php/48101>
- Berners-Lee et al. RFC 2068: "Hypertext Transfer Protocol – HTTP/1.1", pages 11-13 & 18. Published January 1997; <http://www.ietf.org/rfc/rfc2068.txt>
- Pitney Bowes Inc. "iSend Overview", published November 27, 1999. http://www.isend.com/01_overview/index.html (date verified by the Internet Wayback Machine at <http://web.archive.org>)

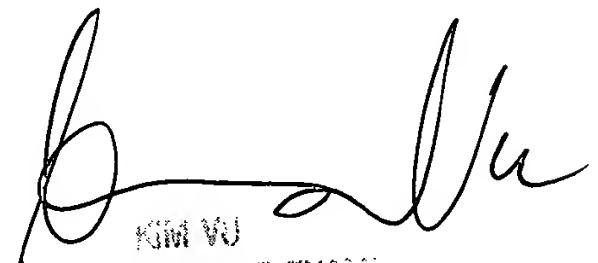
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfí whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG
10/28/04



KIM VU
PATENT EXAMINER
ELECTRONIC BUSINESS CENTER